

pending. Claims 1, 4-6 and 9-11 were rejected under 35 U.C.S. §112 first paragraph as containing subject matter which was not described in the Specification in a manner sufficient to enable one of ordinary skill in the art to practice the invention. Additionally, all of the pending claims stand rejected under 35 U.S.C. §103 as being unpatentable over Catledge et al., *Characterizing Browsing Strategies In The World Wide Web*, http://www.igd.fhg.de/archive/1995www95...terns/user_patterns.paper4, formatted, in view of the U.S. Patent No. 5,724,521 to Dedrick et al.

Applicant turns first to the requirement of a Supplemental Oath or Declaration under 37 CFR §1.67. According to the Examiner a Supplemental Oath or Declaration is required because the present application claims subject matter that was not originally claimed or embraced in the statement of the invention. Applicants' prior stated acquiescence to this requirement notwithstanding, Applicants respectfully traverse. 37 C.F.R. §1.67(b) states that "a Supplemental Oath or Declaration may be required when a claim is presented for matter originally shown or described, but not substantially embraced in the statement of the invention or claims originally presented..." The present case is a Divisional application based on Serial Number 09/005,479, which in turn is a Continuation of Serial Number 08/474,096, now U.S. Patent No. 5,708,870. The disclosure in the present specification is substantially identical to the Parent Application Serial No. 08/474,096. While it is true that the claims filed in the parent application were not drawn to "a method for charging for advertising on the web" nor to "a method of evaluating the effectiveness of advertising on the web," as are the claims in the present Continuation application, it cannot be said that such subject matter was not substantially embraced in the originally presented statement of the invention.

The paragraphs starting on Page 14, Line 14 of the originally filed specification states:

In one embodiment, the time intervals between repeated requests by a common client are measured to exclude those requests falling within a defined period of time.

Additionally, the server may, at any given time, trace access history within a client-server session. Such a history profile informs the service provider about link transversal frequencies and link paths followed by users. This profile is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID (UID). Two subsequent entries, A and B, corresponding to requests from a given user in these logs represent a link traversal from document A to document B made by the user in question. This information may be used to identify the most popular links to a specific page and to suggest where to insert new links to provide more direct access. In another embodiment, the access history is evaluated to determine traversed links leading to a purchase of a product made within commercial pages. This information may be used, for example, to charge for advertising based on the number of link traversal from an advertising page to a product page or based on the count of purchases resulting from a path including the advertisement. In this embodiment, the server can gauge the effectiveness of advertising by measuring the number of sales that resulted from a particular page, link or path of links. The system can be configured to charge the merchant for an advertising page based on the number of sales that resulted from the page.

A casual perusal of these two paragraphs, paragraphs which constituted a portion of the original statement of the invention, makes clear that charging for advertising based on link traversals, or evaluating the effectiveness of advertising based on the number of sales resulting from link traversals from a particular advertisement were subject matter substantially embraced by the original statement of the invention. Accordingly, Applicants respectfully submit that a Supplemental Oath or Declaration according to 37 C.F.R. §1.67 is not required in the present case.

Applicants next address the Examiner's objection to the specification under 35 C.F.R. § 1.73. The Examiner objects that the scope of the Summary Of The Invention section of the specification is not commensurate with the scope claimed invention. Applicants have amended

the Summary Of The Invention to more clearly identify the aspects of the disclosure which are being claimed in the instant continuation application. No new matter has been added as a result of this amendment, as evidenced by the fact that the material added to the Summary was copied nearly verbatim from the Detailed Description Of The Invention section of the specification as originally filed. The Summary of the Invention is now fully commensurate with the scope of the claims. Applicants respectfully submit that the Summary Of The Invention now fully complies with the requirements of 37 C.F.R. § 1.73.

Applicants now turn to the rejection under 35 U.S.C. §112. Claims 1 and 6 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. Specifically, the Examiner asserts that Applicants have not provided an enabling disclosure of “charging for advertising based on link traversals to the page.”

Enablement under the first paragraph of 35 U.S.C. § 112 requires nothing more than objective enablement. *See, Staehelin v. Secher*, 24 USPQ 2d 1513, 1516 (B.P.A.I. 1992). In this regard,

the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by the claim is not adequately enabled by the description of the invention provided in the specification of the application; this includes, of course, providing sufficient reasons for doubting any assertions in the specification as to the scope of enablement.

In re Wright, 27 USPQ 2d 1510, 1513 (Fed. Cir. 1993). Moreover, when the specification

contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken in as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (C.C.P.A. 1971).

The specification of present application clearly enables one skilled in the art to make and use the invention as claimed in claims 1 and 6. Claim 1 requires “determining link traversals leading to a page; and charging for advertising based on link traversals to the page.” Claim 6 requires, among other things, tracking access history; determining link traversals based on access history; determining the number of link traversals leading from a first document to a second document; and charging for advertising based on the number of link traversals to the second document. Both of these processes are described in detail in the specification.

In an embodiment of the invention described at page 14, line 17 through page 15, line 6 of the specification, a server tracks access history within a client-server session. A history profile is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID. This history profile informs the service provider about link traversal frequencies and link paths followed by each user. The access history is then evaluated to determine traversed links leading to, for example, a purchase of a product page within commercial pages. This information may then be used, for example, to charge for advertising based on the determined link traversals. For instance, the advertiser might be charged for each of the determined link traversals from an advertising page to a product page. Alternatively, the charge to the advertiser could be based on the number of purchases resulting from a path that includes the advertisement. Applicants respectfully submit that this disclosure is more than sufficient to enable one of ordinary skill in the art to practice the methods called for in the pending claims. Accordingly, the rejection of claims 1 and 6 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

Claims 4-5 and 9-11 also stand rejected under 35 U.S.C. § 112, first paragraph. According to the Examiner these claims also contain subject matter which is not described in the

specification in such a way as to enable one skilled in the art to make and/or use the invention. Specifically, the Examiner asserts that Applicants have not provided a detailed disclosure of the step of “measuring the number of sales or transactions resulting from link traversals.” Again, the Examiner is mistaken in this assertion. Page 14, line 17 of the specification clearly states that the server may, at any given time, track access history within a client-server session. An history profile is produced by filtering transaction logs from one or more servers to select only transactions involving a particular user ID. These transaction logs include all transactions made using a particular user ID, including purchasing products. As described at page 14, line 24 of the specification, in an embodiment of the invention the access history is evaluated to determine which links have been traversed leading to the purchase of a product. Applicants are at a loss to determine how the step of “measuring the number of sales (or transactions) resulting from link traversals” could be enabled more fully. On the contrary, Applicants respectfully submit that the subject matter of claims 4-5 and 9-11 is fully enabled in the Specification and that the rejection under 35 U.S.C. § 112, first paragraph should be withdrawn.

Turning now to the rejection based on the prior art, claims 1-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Characterizing Browsing Strategies in The World Wide Web* in view of United States Patent No. 5,724,521 to Dedrick.

Applicants note that in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference themselves or within the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, all of the claim limitations

must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ, 580 (CCPA 1974). In this respect, “[o]bviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination.” *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q.2d 929, 932 (Fed. Cir. 1984).

The claimed invention is not obvious over the combined teaching of Catledge et al. and Dedrick for at least two reasons. First, there is no teaching or suggestion within the references themselves or within the knowledge generally available to those skilled in the art that would have led one of ordinary skill in the art to make the combination suggested by the Examiner. Second, even when combined, Catledge et al. and Dedrick do not teach or suggest every element of the claimed invention.

The Examiner asserts that it would have been obvious for one of ordinary skill in the art at the time of the present invention to modify Catledge et al.’s study of browsing strategies to incorporate the feature of charging for advertising as taught by Dedrick. Catledge et al. describe a study that captured client-side user events during web browsing sessions using a web browser. *See*, Catledge et al., Abstract. Catledge et al. further disclose that the information captured during the study provides design and usability suggestions for web pages, web sites and browsers. Catledge et al. make no reference to the desirability of advertising on a web page or web site, nor do they make any reference to charging for advertising placed on the web, and especially not to charging for advertising based on link traversals to a web page.

The Examiner cites Dedrick for teaching the feature of charging for advertising based on the number of link traversals from a first document to a second document. Dedrick discloses a method and apparatus for providing electronic advertisements to end users in a consumer best-fit

pricing manner. As will be discussed in more detail below, Applicants' argue that Dedrick does not in fact teach or suggest charging for advertisements based on the number of link traversals from a first page to a second page. Nonetheless, the Examiner states that it would have been obvious to combine the browsing strategies analyzed by Catledge et al. with the method for providing electronic advertisements in a consumer best-fit pricing system disclosed by Dedrick. However, the Examiner fails to point to any suggestion or teaching within the references or within the art generally which would have led one of ordinary skill to make the suggested combination.

In her Office Action the Examiner states that the motivation to combine "would have been to use the information determined from characterizing user browsing sessions and simply [sic] the calculations necessary to charge advertisers." But this is a mere conclusory statement which relies on impermissible hindsight using the Applicants claim as template. The Examiner points to no teaching in the prior art that indicates that monitoring link traversals and charging advertisers based on link traversals would simplify the calculations necessary to charge advertisers. In fact, charging a flat fee for placing advertisements would be far simpler. Thus, mere simplification of the calculations would not serve as motivation to make the combination suggested by the Examiner.

There simply is no suggestion or motivation in the references themselves that supports the combination made by the Examiner. Catledge et al. make no mention of advertising whatsoever. Dedrick never avers that monitoring link traversals and Internet usage patterns would have the slightest efficacy in improving his method of charging for advertising. The Examiner's statement to the contrary notwithstanding, one of ordinary skill in the art would not have been motivated to combine the method of charging for advertising as taught by Dedrick

with the study of browsing strategies as taught by Catledge et al. Because there is no teaching or suggestion to combine within the references themselves or within the general knowledge of those skilled in the art, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103 and claims 1-12 must be allowed.

Furthermore, even if one of ordinary skill in the art would have been motivated to combine the teachings of Catledge et al. with that of Dedrick as suggested by the Examiner, the resulting combination does not teach or suggest every element of the claimed invention. Claims 1, 4, 5 and 6 are the only independent claims pending in the application. As noted above, claim 1 calls for the steps of determining link traversals leading to a page and charging for advertising based on link traversals to the page. Claim 4 calls for determining link traversals leading from an advertisement to a page and measuring the number of sales resulting from link traversals from the advertisement to the page. Similarly, claim 5 calls for determining link traversals from an advertisement to a page, and measuring the number of transactions resulting from link traversals from the advertisement to the page. Generally, claim 6 calls for tracking access history, determining link traversals from a first document to a second document based on the access history; determining the number of link traversals leading from the first document to the second document, and charging for advertising based on the number of link traversals to the second document. A feature common to all these claims is determining link traversals that lead to a particular page, such as, for example, a product page. Generally, the link traversals originate at a first page which may be an advertisement or advertising page. With regard to claims 1 and 6 advertisers are charged based on the link traversals to the page. Claims 4 and 5 require measuring the number of sales or transactions that result from link traversals from the advertising page.

The Examiner admits that Catledge et al. do not teach or suggest charging for advertising based on link traversals from the first document to the second document as claimed in claims 1 and 6 of the present application. To remedy this deficiency, the Examiner relies on Dedrick. However, Dedrick also fails to teach or suggest the step charging for advertising based on the link traversals from the first document to the second document as required by claims 1 and 6.

Dedrick teaches a system of charging for advertising based on the advertisements being actually consumed by members of a predefined target audience. An advertiser generates a “consumer scale” that provides a range of consumer variables that must be satisfied by the users who actually consume an advertisement before the advertiser is required to pay a specified price. Col. 4. Line 59 to Col. 5 Line 4. Further, the advertiser may assign different “weights” to each consumer variable, where these weights are compared to thresholds that must be met before the advertiser is required to pay a corresponding fee associated with the advertisement. Col. 6. Lines 12 to 32. For example, Dedrick teaches that “the advertiser 18 may select a consumer threshold scale [where] at least 60% of the variables must be met by at least 75% of the end users coupled to the metering server 14 in order for the advertiser 18 to pay the highest fee.” *Id.* Thus, whereas Dedrick teaches a system of charging for advertising based on advertisement consumption by a targeted group of end users according to a weighted scale of consumer characteristics, Dedrick does not teach or suggest charging for advertising based on the number of link traversals from a first document to a second document as required by claims 1 and 6 of the pending application. As such, even when the Catledge et al. and Dedrick references are combined, they fail to teach or suggest every element of claims. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness with regard to claims 1 and 6 and the claims depending therefrom, and the rejection under 35 U.S.C. §103 should be withdrawn.

Similarly, Dedrick also fails to teach or suggest the step of measuring the number of sales or transactions resulting from link traversals from an advertisement to a second page as required by claims 4 and 5. As indicated above, Dedrick's system is premised on charging for advertising based on the advertising materials being consumed by the pre-selected target audience. Dedrick is silent regarding monitoring the number of sales or transactions which result from the end user's consumption of the advertising materials. Thus, since Catledge et al. say nothing related to advertising, and Dedrick does not teach or suggest measuring the number of sales or transactions resulting from link traversals from the advertising page, the Examiner has again failed to establish *prima facie* obviousness with regard to claims 4 and 5 and the rejection of these claims under 35 U.S.C. §103 should also be withdrawn.

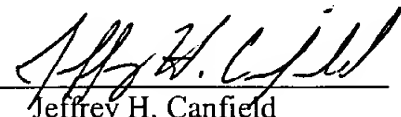
In light of the present amendment to the specification and the preceding remarks, Applicants respectfully submit that all of the pending claims are allowable over the art of record, and ask that the Examiner withdraw the Rejection entered in the case and allow the application to issue. However, if there are any remaining issues the Examiner is encouraged to call Applicant's attorney, Jeffrey H. Canfield at (312) 807-4233 in order to facilitate a speedy disposition of the present case.

If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Jeffrey H. Canfield

Reg. No. 38,404

P.O. Box 1135

Chicago, Illinois 60690-1135